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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,545	03/22/2001	Allen R. DeCotiis	PNX1P002	6466

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EXAMINER
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HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/815,545

**Applicant(s)**

DECOTIIS ET AL.

**Examiner**

Calvin L Hewitt II

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

### ***Status of Claims***

1. Claims 1-20 have been examined.

### ***Response to Arguments***

2. Claim 1 and 15 are not in the technological arts as they do not use a computer or computer technology to implement Applicant's claimed method.

All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts" (*In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970)).

Claim 8 is also non-statutory as it is directed to computer code not stored on a computer-readable medium (MPEP 2106-11 "Nonstatutory Subject Matter"; *In re Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759).

Applicant claims a method comprising retrieving a "first information" on a user and then collecting "second information" via a survey. *Jacobi et al.* teach querying users in order to collect data such as user opinions regarding a particular book (column 8, lines 26-37), hence *Jacobi et al.* collect Applicant's "second information". The system then processes user data (first information, second information) using a model in order to derive a score specifying books, for example, that might be of interest to a user (i.e. a propensity to buy) (column

15, lines 55-62). Jacobi et al. also teach retrieving user (user A, user B- figure 3, item 102A) purchase histories (e.g. first information) from a list (i.e. database- figure 3) and using weighted characteristics (figure 5). The Applicant did not explicitly define the term “characteristics”, hence it is broad enough to read on the “weighted similar items” of Jacobi et al..

Regarding the combination of Jacobi et al. and Herz et al., Jacobi et al. teach a system for recommending books to users. Specifically, Jacobi et al. teach modeling user interests based on purchase history and derived similarities between books (column/line 2/32-3/20). Therefore, it would have been obvious to combine Jacobi et al. with the teachings of Herz et al. in order to more accurately predict a user's interests by comparing said user's profile (say) to other users of a similar profile.

The Examiner maintains the rejection.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter.

4. Claims 1-20 are rejected under 35 U.S.C. 101 because:

The Applicant's claimed invention does not fall within the technological arts because no form of technology is disclosed or claimed. The claims recite a process for calculating a score without utilizing a computer or computer-related technology. Therefore, the claimed invention does not promote the progress of science and the useful arts.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 4-8, 11-15, and 18-20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Jacobi et al., U.S. Patent No. 6,317,722.

As per claims 1, 4-8, 11-15, and 18-20, Jacobi et al. teach a method for providing a model indicating a propensity of an individual to have a particular attitude, behavior or demographic comprising:

- identifying a plurality of users (figure 1; column 7, lines 45-64)
- retrieving first information on each of the individuals (figure 1; column 7, lines 45-64)
- conducting a survey to collect second information from each of the individuals (figure 1; column 8, lines 26-50)
- creating a model that defines a relationship between the first and second information (column 14, lines 46-55)
- calculating a score for each individual based on the first information, the second information and the model, wherein the score represents a propensity of the individual to have a particular attitude, behavior or demographic (column/line 14/31-16/19)
- first information from a list (figure 3)
- second information that includes information on a purchase intent (figure 1; column 8, lines 26-50)
- a model that sets forth a plurality of characteristics and a weight of each of the characteristics for calculating the score (column/line 14/56-15/55)
- an equation based on first information, second information and the model to generate a score (column/line 14/56-15/55)

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 3, 9, 10, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobi et al., U.S. Patent No. 6,317,722 in view of Herz et al., U.S. Patent No. 5,754,938.

As per claims 2, 3, 9, 10, 16, and 17, Jacobi et al. teach a method for calculating a score that measures the propensity of the individual to have a particular attitude, behavior or demographic (column/line 14/31-16/24). However, Jacobi et al. do not specifically recite sorting individuals based on said score. Herz et al. teach a method for sorting individuals based on a score (column 20, lines 9-40; column 23, lines 40-53; column 41, lines 43-67; column 56, lines 9-24; column 60, lines 1-33). Herz et al. also teach enabling a user to control which third parties have access to said user's profile. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Jacobi et al. and Herz et al. in order to refine the recommendation process ('722, abstract; '938, column 60, lines 1-32) by storing user attributes such as purchase history ('722, figure 1; '938, column 11, lines 10-33; column 20, lines 9-40) and directing

recommendations based on additional criteria such as user sorting or clustering ('938, column 41, lines 43-67; column 56, lines 9-25; column 60, lines 1-33).

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.



If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 2100  
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

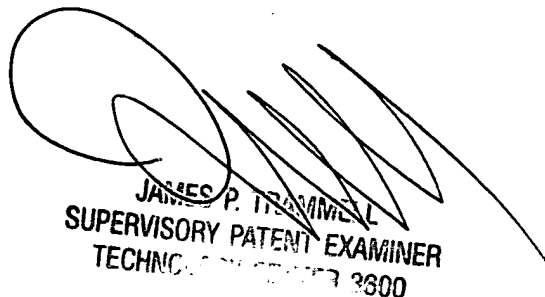
or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II  
December 7, 2004

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100